



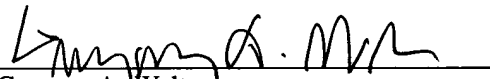
JK AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 9137.00)
Group Art Unit: 3292)
Serial No.: 09/522,085)
Examiner: Frantzy Poinvil)
Filing Date: March 10, 2000)
Title: Self Service Terminal)
_____)

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on May 21, 2008.



Gregory A. Welte

REPLY BRIEF

SUMMARY OF REPLY

Point 1

Suer shows a portable device (eg, a PDA, Personal Digital Assistant) containing a display 55 onto which a user writes using an electronic pen 57. The user actually places a paper check on the display 55, and writes the check in the normal manner. The display 55 captures the writing and stores it. (Column 8, line 11 et seq.)

The Examiner's Answer ("Answer" herein) asserts that Suer's PDA shows the claimed "telephone." Suer's PDA is not a "telephone."

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Further, no other "telephone" has been shown in the references.

Thus, the claimed "telephone" has not been shown, as required.

Point 2

The Answer asserts that a well known cell phone can be substituted for Suer's PDA. However, if that is done, then the display 55 on Suer's PDA goes missing. The user cannot write a check, as Suer teaches.

The modification renders Suer inoperative for his intended purpose. MPEP § 2143.01 states:

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE

If proposed modification would render the
prior art invention being modified
unsatisfactory for its intended purpose, then
there is no suggestion or motivation to make
the proposed modification.

Appellant submits that this point, by itself, is dispositive of the appeal.

Point 3

The Answer, in essence, is asserting that the claimed cell phone (or wireless phone) can be substituted into Suer, on the

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grounds of equivalence.

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art,**

and

cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

No showing has been made that the equivalency is recognized in the prior art.

Point 4

Suer is rendered incapable of achieving his goal, for another reason. This requires a brief explanation of one of Suer's goals.

Goal of Suer

Suer states that many people are now using computer software to handle their finances, wherein the people (1) enter data into computers, and (2) print out graphs and charts. These people keep their financial records in the computer, or PC. (Column 1.)

Suer states that people also use portable devices, such as PDAs, to undertake financial transactions.

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He states that, for people who use both PCs and PDAs, a problem arises in reconciling the data within the PDA with a PC, because people must manually transfer data from one to the other. (Column 2; column 3, line 9 et seq.)

Suer proposes a PDA which displays a screen representing a bank check. The user "writes" the check on the screen, and the portable device records the financial data. (Summary of Invention, first three paragraphs.) The PDA can also handle other transactions.

Suer also proposes an Infra-Red link with the user's PC, by which the portable device can transfer data to and from the PC. (Column 4, line 30 et seq.)

Therefore, one of Suer's goals is to transfer financial data between a PDA and a PC.

The Problem

If a cell phone is substituted for Suer's PDA, there is no financial data contained in the cell phone. Thus, Suer's goal of transfer of financial data between the cell phone and the PC cannot be achieved.

Suer is rendered incapable of achieving his intended purpose. That is not allowed.

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Point 5

A key basis of the Answer's position is

- 1) the classification of Suer's PDA as a "wireless device," and
- 2) the assertion that this classification makes it obvious to substitute another wireless device.

For example, the Answer, page 16, third paragraph, states:

. . . wireless devices include PDA's and cell phones and wireless phones,

and

it would have been obvious to . . . include a wireless telephone device in . . . Suer in order to attract many types of users . . . having different types of portable devices.

Appellant points out that this reasoning is invalid, for several reasons.

REASON 1

The Answer is asserting that both PDAs and cell phones are species of the genus "wireless devices." However, MPEP § 2144.08 states that, if a genus is taught in the prior art, whether a species of that genus is obvious is resolved by a case-by-case determination.

Thus, even if the Answer's premise is correct, use of a cell

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phone in Suer can still be patentable.

REASON 2

Suer shows a portable device which has **specific characteristics**.

- It stores financial data.
- It has a display 55 onto which a paper check can be placed, and which stores data written onto the check.
- It transfers data to, and from, a PC using an infra-red link.

If other portable devices are substituted, then Suer is rendered inoperative.

REASON 3

The goal of attracting "many types of users having different . . . portable devices" to an ATM contradicts Suer's teachings.

Suer's ATM represents only one embodiment of his invention. As explained above, Suer wants his PDA user to be able to transfer financial data to, and from, a PC.

Plainly, Suer is referring to a **user's own PC**. Why would a user want multiple different devices to store financial data, and transfer that data to a PC, when a **single device (ie, Suer's PDA)** is sufficient ? Why would multiple users make transfers to that

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PC ?

Point 6

Point 6A

A key, if not essential, element of the Answer's reasoning is that the claimed telephone and Suer's PDA are both classified as "wireless devices."

Appellant submits that no reasonable basis has been given for making this classification, and thus the classification is irrelevant.

For example, a mousetrap is a "wireless device." If baited with peanut butter, it attracts a mouse "wirelessly" by scent, and then kills the mouse. Does that mean that a mousetrap can be substituted for Suer's PDA ?

If this classification is to act as a teaching, then an explanation of its relevance must be given.

For example, one can also classify the telephone and PDA as "electronic devices." But that is irrelevant, as to whether one should be substituted for the other. A stereo amplifier is also an "electronic device," but Appellant fails to see why it should be substituted into Suer for that reason.

One can also classify the telephone and the PDA as made of matter. That is clearly correct, but clearly irrelevant.

Appellant submits that "wireless device" is simply **the wrong**

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classification. The real question is this: "What are the relevant characteristics of the PDA/device in Suer ?" Some of those characteristics are these:

- 1) storage of financial data,
- 2) display 55 onto which a paper check can be placed, and written to by electronic pen 57,
- 3) capture and storage of the writing of (2) above, and
- 4) transfer of stored data to, and from, a PC, using the "IR receiver."

No generic "wireless device" possesses those characteristics.

Thus, the classification as Suer's PDA/device as a "wireless device" is incorrect under section 103. That classification cannot lead to a substitution of another "wireless" device, because other "wireless devices" do not possess the characteristics needed to accomplish Suer's goals.

Point 6B

The Answer has selected a **single characteristic** of Suer's PDA/device, namely, that it is "wireless."

However, that **single characteristic** fails to describe the features required by Suer. Thus, that **single characteristic** cannot be used to find a substitute, such as a cell phone, as the

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Answer purports to do.

By analogy, fishing line has numerous characteristics, such as being made of Nylon. Does that mean that anything made of Nylon can be used as fishing line ? Of course not.

Similarly, not everything which is "wireless" can be used in Suer.

Comment

Not all points made in this Summary are elaborated below. Some are considered self-explanatory.

END SUMMARY

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REPLY BRIEF

**Re: Examiner's Answer ("Answer" Herein),
Page 1, Section 1, - Page 3, Section 8**

No reply is needed.

Re: Answer, Pages 3 - 7 (Section 9)

This part of the Answer is largely a repetition of the Final Office Action. No reply is needed: the Brief addresses this part.

**Re: Answer, Page 7, Paragraph Beginning "Appellant argues . . ."
To Page 8, End of First Paragraph**

Point 1

The undersigned attorney interprets Suer as teaching that the IR receiver of column 4, line 31, is installed into the ATM at the site of manufacture of the ATM. One reason is that, plainly, software "drivers" must be installed to allow the ATM to communicate with the IR receiver.

Another reason is that the IR receiver must be tested after installation.

Appellant points out that Suer is short on details of the ATM. One reason appears to be the fact that Suer focuses on his own invention, namely, the PDA which communicates with a PC or ATM or point of sale terminal. In fact, that invention is

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covered by Suer's claims.

It is a question of interpretation of Suer, as to where the IR receiver is installed.

But one thing seems certain. The owner of the PDA in Suer **DOES NOT** install the IR receiver. No ATM owner would grant access to the ATM for that purpose.

**Re: Answer, Page 8, First Full Paragraph
To Page 9, First Full Paragraph**

The issue is whether Suer shows an operative ATM, as claimed, prior to installation of his IR receiver.

The passages cited by the Answer do not show this.

Those passages merely discuss the operation of Suer's ATM, but **after** the IR receiver has been installed.

Those passages can be discussing the ATM of Suer, after delivery from its site of manufacture.

Again, this is a question of interpretation.

**Re: Answer, Page 9, Second-to-Last Paragraph
To Page 10, End of First Paragraph**

Appellant asserted that Suer fails to show an ATM which dispenses cash in response to commands from a **cell phone**, as claimed. The Answer asserts that it rebuts this.

The Answer relies on a passage from Suer (column 6, line 38 et seq.) However, nowhere does that passage mention a telephone

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of any kind.

No cell phone has been shown in Suer, let alone a cell phone which instructs an ATM to dispense cash.

No rebuttal has been made.

**Re: Answer, Page 10, Second-to-Last Paragraph
To Page 11, End of First Paragraph**

Point 1

First, a correction. The Answer states:

The only difference between Suer . . . and the claimed invention is that Suer . . . makes use **of an ATM** whereas the claimed invention makes use of a cell phone.

Appellant submits that "of an ATM" should be "of a PDA."

In addition, the Answer's statement is incorrect. There is no generalized, single, "claimed invention." One looks at each individual claim.

As to the individual claims, as the Brief explains, elements are recited in the claims which are not shown in Suer.

Point 2

The Answer asserts that the "same IR as installed in the PDA can also be attached in a portable phone . . ." Appellant points out that this is a naked conclusion. Evidence is required.

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Point 2A

The undersigned attorney owns both a cell phone (a Nokia TracFone) and a PDA (a Palm Pilot Tungsten T2.)

On or near the date of mailing of this Reply Brief, he examined both items. He can see no attachment plugs on both which could accept a common plug, as from the "IR receiver" of Suer. (One possible exception is a power jack, which appears on both, but which is irrelevant.)

Therefore, the Answer's assertion is incorrect as to these two items. The undersigned attorney has just given an example showing that something which plugs into a PDA cannot also plug into a cell phone.

This is consistent with Suer's teachings. He states that the "IR receiver"

. . . may be plugged into the . . . serial,
parallel, Universal Serial Bus (USB), or IrDA
port . . .

The undersigned attorney's cell phone has none of these.

Therefore, it has just been shown that the Answer's assertion is incorrect, at least with respect to a specific cell phone. And Suer states that the IR receiver plugs into four specific terminals, none of which cell phones appear to possess.

Thus, evidence is required in support of the Answer's assertion.

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Point 2B

This requirement of evidence is further supported by the fact that the Answer is invoking the Doctrine of Equivalence.

The Answer is asserting that, in the respect of attachment to the (unidentified) IR receiver in Suer, both a PDA and a cell phone are "equivalent."

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

No "recognition" in the prior art has been shown.

Point 3

In order for the claims to read on the elements in the prior art which have been combined, those elements must include the "IR receiver" which plugs into a cell phone. Such an IR receiver has not been shown in the prior art. That is, the claim language does not read on Suer-plus-cell-phone, if the cell phone does not communicate as claimed.

From another perspective, until such an IR receiver is shown, no expectation of success has been shown, as required by

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MPEP § 706.02(j).

The rejection is relying on a specific property of the "IR receiver" of Suer, namely, that it supposedly can be attached to a cell phone.

This property must be shown in the prior art.

Point 4

The Answer states: "attaching wireless means to provide remote communication was old and well known in the art."

Appellant submits that this is a meaningless, non-specific statement.

Re: Answer, Page 11, First and Second Full Paragraphs

This section contains nothing but naked conclusions.

In essence, this section states that one can substitute a wireless phone for the PDA of Suer "in order to achieve the same result of remote communication with the ATM."

However, this statement overlooks a fatal flaw.

Suer's PDA has a display screen ("writing surface") 55 onto which the user can write using electronic pen 57. The user can write a paper check or paper deposit slip, and the display 55 captures the writing. (Column 7, line 41; column 8, line 11 et seq.)

If a wireless telephone is substituted, then the "writing

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surface 55" is now absent. Suer is precluded from accomplishing his intended function.

MPEP § 2143.01 states:

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE

If proposed modification would render the
prior art invention being modified
unsatisfactory for its intended purpose, then
there is no suggestion or motivation to make
the proposed modification.

A cell phone is not a substitute for Suer's PDA.

Re: Answer, Page 11, Second and Third Paragraphs from End

Point 1

Claim 2 recites a "program." This "program" has not been shown in the prior art.

If the Answer is asserting that the "program" is inherent in Suer, then Appellant points to MPEP § 2112:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

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Point 2

The undersigned attorney owns a PC which runs the Windows XP operating system. He owns a digital camera, which stores pictures on a "flash card." He also owns a Lexar "USB 2.0 MULTI-CARD READER," which plugs into the PC. He can remove the flash card from the camera, and insert it into the Lexar device, to transfer pictures into the PC.

The Lexar unit was packaged with software "drivers." However, Windows XP also came equipped with "drivers," so that the Lexar drivers were not needed.

This is an example of a plug-in accessory which needed no software to be installed.

Since the "IR driver" of Suer has not been identified, it is not known whether drivers are needed. Thus, at best, it is indeterminate as to whether the "programs" of claim 2 are found in Suer.

Re: Answer, Page 11, Last Paragraph

Point 1

Claims 3 and 25 are in question. Claim 3 recites:

. . . retrofitting said ATM with a
transceiver adapted to receive signals
directly from the wireless telephone

The "IR receiver" of Suer's column 4, line 31, does not

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"receive signals directly from" any **wireless telephone**, as claimed. The "IR" in "IR receiver" of Suer refers to infra-red light.

A "wireless telephone" does not use IR signals. If it did, you could not use that telephone to talk to another person in a different room. IR light will not penetrate walls.

IR signals, being light signals, only travel in a line-of-sight. Further, rain and fog block such signals.

Wireless telephones do not use such signals.

The IR receiver in Suer will not communicate with the claimed telephone.

Point 2

The Answer is self-contradictory. At this location, it asserts that the IR receiver of Suer will communicate with the claimed telephone.

At other location(s) (eg, page 11, first paragraph), the Answer states that "the same IR as installed **in a PDA** can also be attached in a portable phone . . ." Thus, at this location the Answer states that something must be **installed** in a phone to allow IR communication.

This location contradicts the passage in question (last paragraph on page 11).

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Re: Answer, Page 12, First Paragraph

Point 1

Claims 22 and 23 refer to "said ATM." "Said ATM" has the properties of the parent claims, such as being operative to dispense cash, etc.

It is a question of interpretation whether Suer shows such ATMs.

Further, "said ATM" has a device attached to it which communicates with a wireless telephone, or cell phone. That has not been shown in Suer.

Point 2

Appellant submits that the Answer is self-defeating.

The Answer, at other locations, asserts that Suer's "IR receiver" qualifies as the claimed modification which dispenses cash in response to signals from a cell phone.

If so, then, it must be shown that Suer's "IR receiver" is previously absent, as recited in claims 22, 23, and 26 - 28. That has not been done.

For example, claim 23 states: "prior to modifying, no ATMs could receive user commands for dispensing cash from a wireless telephone." Thus, **every (relevant) ATM**, prior to the claimed modifying, cannot dispense cash in response to commands from a wireless telephone.

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That has not been shown in Suer.

Re: Answer, Page 12, Second and Third Paragraphs

Claim 29 states that "communication between the wireless telephone and the ATM occurs through the network."

Suer does not show that. He discusses IR communication, in which **light rays** travel from his PDA **directly** to the ATM.

Suer states that LEDs 106 are used for this communication. (Column 9, line 31 et seq.) That is not "the network," as claimed.

The LEDs must be able to "see" each other. They do not use "the network."

Re: Answer, Page 12, Last Three Paragraphs

It is a question of interpretation as to whether Suer shows the claimed operative network of ATMs, which are then modified as claimed.

Re: Answer, Page 13, First Paragraph

Point 1

The Answer is self-defeating.

Appellant argued that no ATM is present which dispenses cash in response to a cell phone.

The Answer asserts that such is "obvious."

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The Answer thus admits the validity of Appellant's argument.

That is, the Answer admits that the ATM, as recited, is not present, but that such an ATM is "obvious."

Point 2

SUMMARY OR POINT 2

The Answer is mis-using the term "obvious."

Only inventions can be "obvious."

Certain claims recite an ATM having a specific property.

But the claims contain other recitations.

The specific property cannot be obvious," because the term "obvious" only applies to inventions, ie, to entire claims.

DETAILS ON POINT 2

Appellant asserted that, in Suer, there is no resulting ATM which dispenses cash in response to commands from a cell phone. This will be called the Specific ATM.

The Answer asserts that the Specific ATM is "obvious" in view of Suer.

Appellant points out that only **claims** can be obvious. At best, the Specific ATM can be only **part of a claim**.

Further, as repeatedly stated herein, no cell phone has been shown in Suer.

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Re: Answer, Page 13, Second and Third Paragraphs

This section of the Answer is filled with errors.

Point 1

In the second paragraph, the Answer first asserts that Suer teaches modifying an ATM to be used with a remote portable device. That is not correct.

The portable device in Suer is not "remote." It is **adjacent** the ATM, and it must be so, because LEDs, and IR light, are used to communicate. (Column 9, line 31 et seq.)

The limits on such communication are well known. For example, an ordinary TV "remote" uses IR light. How far away can the remote be moved from the TV, and still function ?

Point 2

The Answer asserts that adding the "same installation" to a cell phone would be "obvious," because that "would not teach away from Suer." However, several problems exist in this statement.

PROBLEM 1

It was just shown that the "same installation" is not even found in Suer. (The "same installation" supposedly allows "remote" communication. But Suer's PDA cannot be "remote." It uses IR light.) Thus, that (absent) "same installation" cannot

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be added to a cell phone, because it is not even present in Suer.

PROBLEM 2

Whether the "same installation" is "obvious" to add to a cell phone is not an allowed question. (Answer, third paragraph, second sentence.)

Only claims can be obvious.

No claim recites modifying a cell phone by adding the "same installation" to it.

PROBLEM 3

The Answer is asserting that, if Item A does not "teach away" from Suer, then combining Item A with Suer is "obvious." (Answer, third paragraph, second sentence.)

That fails to state the law of obviousness.

Further, Appellant respectfully submits that the assertion is absurd. The undersigned attorney owns a cat named Dixie. Dixie has never "taught away" from Suer. Is it therefore "obvious" to combine Dixie with Suer ?

Appellant requests a citation of authority in support of the Answer's position.

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Re: Answer, Page 13, Last Two Paragraphs

Point 1

The Answer is relying on a non-substantiated distinction.

On the one hand, the Answer is asserting that adapting **some** remote-control devices for interaction with Suer would require undue experimentation. Thus, the Answer implies, the person skilled in the art would not choose them.

On the other hand, the Answer asserts that adapting a **cell phone** would not require undue experimentation.

No evidence supporting this distinction has been submitted. Evidence is required.

Point 2

The Answer is pre-supposing a need for replacing the PDA of Suer with something else. But no such need has been shown in the prior art.

Point 3

Again, replacing Suer's PDA with a cell phone renders Suer incapable of performing his intended tasks. His user can no longer write checks using the electronic pen 57. His user can no longer transfer data to a PC.

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Point 4

This is a small point. The Answer, in effect, asserts that no undue experimentation is required in combining certain remote devices with Suer.

Undue experimentation is irrelevant. That is part of a standard for enablement. It is not related to obviousness.

Re: Answer, Page 14, First and Second Full Paragraphs

The Answer's second full paragraph does not, as a matter of logic, rebut Appellant's argument described in the first full paragraph.

That is, the Examiner may have (1) provided "an obviousness statement" and (2) pointed to the Norris and Gustin references. But those two elements are irrelevant to whether the Examiner interpreted the claims by ignoring a "wherein" clause.

For example, the Examiner can ignore a "wherein" clause **even if** the "obviousness statement" and the Norris and Gustin references **never existed**.

Appellant points out that "wherein" means "in which." In this case, the "wherein" clause sets forth characteristics of a recited claim element. The "wherein" clause **defines** (in part) the element.

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Re: Answer, Page 14, Third Full Paragraph

Point 1

The Answer has still not identified the claimed "identifying" step.

For example, claim 8 states that the identified ATM is one of a group of ATMs. No group has been shown in Suer.

Point 2

The Answer is guilty of double-counting.

The Answer is asserting that,

- if a **single** ATM is present in Suer, and
- a person installs the "IR receiver" in that ATM, then, therefore,
- that person has "identified" the ATM.

This is double-counting. It counts the **installation** step as also an **identifying** step.

From another point of view: **when** does the "identifying" occur in this situation ? It occurs simultaneously with the installation. However, plainly, under the claims, the identification occurs **prior to** the installation.

The basic problem is that the Answer is trying to find a step (identifying) in a process where identification has no logical presence.

Perhaps "isolation" or "selection" or "exclusion" would be

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better terms to describe the process, which entails selecting an ATM in a group, and processing that ATM, to the exclusion of other ATMs. Appellant offers to amend the claims, if the Board so directs.

Re: Answer, Page 14, Last Two Paragraphs

The issue is whether Suer shows a teaching for modifying an ATM **as claimed**. Nothing in Suer leads to an ATM which receives instructions from a cell phone to dispense cash.

Adding a cell phone to Suer renders Suer incapable of performing his intended tasks, such as writing on display 55 using pen 57, and transferring financial data to a PC.

Re: Answer, Page 15, First and Second Full Paragraphs

The question is one of interpretation, namely, whether Suer shows the four characteristics of claim 1(a) and the six enumerated characteristics of claim 8.

Further, the Answer asserts that the modified ATM in Suer can then receive wireless communications.

The claims do not recite that. They recite a cell phone, or similar.

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Re: Answer, Page 15, Last Two Paragraphs

Point 1

The claim language is "wireless **TELEPHONE**" or "cellular **TELEPHONE**." It is not "wireless **DEVICE**."

Point 2

The Answer is implicitly asserting that, if a reference teaches an item, then the reference also teaches everything in the generic class containing that item.

That is false.

A showing of a genus in a patent-reference does not preclude a different patent on a species of that genus.

Further, the Answer is not even complying with this MPEP rule. The Answer is asserting that, if a **species** (not a genus) is found in the prior art (eg, Suer's PDA), then **OTHER SPECIES in the same genera (wireless devices) are taught by that prior art.**

That assertion is plainly incorrect.

Point 3

The Answer has not shown that the genus on which it relies ("wireless devices") is logically dispositive.

For example, both Suer's PDA and the claimed cell phone are made of matter. Is that genus ("matter") sufficient to infer that Suer teaches a "material" cell phone ? If so, then does

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Suer also teach other "matter," such as a set of mechanical fingers 40 feet long which allow a user to actuate keys remotely at the ATM ?

As another example, both Suer's PDA and the claimed cell phone require electrical power. Does that mean that Suer implicitly teaches that all electrically powered devices can be substituted for his PDA ?

Plainly not.

Therefore, Appellant submits that any characterization of Suer's PDA/device must be **relevant**. It must set forth relevant features of the PDA/device, to thereby allow the person skilled in the art to look for substitutes. That has not been done. "Wireless device" does not describe the relevant features.

Point 4

"Wireless device" merely sets forth a **single characteristic** of Suer's PDA/device.

That is insufficient to act as a basis for substituting other devices.

Fishing line can be made of Nylon. Does that mean that anything made of Nylon can suffice as a fishing line ? No.

Re: Answer, Page 15, Last Two Paragraphs

As to the second-to-last paragraph, on May 21, 2008, the

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undersigned attorney re-read the Appeal Brief. He cannot locate the assertions attributed to the Brief.

He does agree that Suer does not teach a wireless telephone's issuance of commands, because Suer shows no wireless telephone. The Answer, as explained herein, agrees that Suer shows no wireless phone.

As to the second paragraph, the undersigned attorney again cannot locate the assertions mentioned. But he points out that the IR communication of Suer is **completely different** from communication using a cell phone.

- IR communication is line-of-sight only.
Walls block an IR signal.
- Cell phone signals can go through walls.
- IR communication is "short," like that in a TV remote.
- Cell phone signals can travel for miles.
- Cell phone signals go to a cell tower (or satellite) and thence to a cell-system, where they are translated into signals usable in the land-line telephone system. Suer's IR signals do not do that.

Re: Answer, Page 16, First Two Paragraphs

Appellant pointed out that the keyboard on Suer's PDA is

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used **instead of** the keyboard on the ATM. Appellant did not say that a second keyboard of a PDA is used in addition to a first keyboard of a PDA.

Re: Answer, Page 16, Third Paragraph

Point 1

This paragraph has been addressed above, in the Summary.

Point 2

If you merely add a cell phone to Suer, you do not implement Suer's invention. As explained above, display 55 is no longer present, so that checks cannot be written on it, using pen 57. You cannot transfer financial data to a PC.

Thus, it is not clear at all that this modification will "attract many types of users . . ." etc., as the Answer asserts.

The system of Suer has been changed, so it is possible that **fewer** users would be interested.

In any case, evidence is required showing that more users are attracted by the modification. No evidence has been given.

Point 3

The Answer points to a goal: attracting different users, with different devices.

The Answer has not shown any logical connection between (1)

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pursuit of that goal, and (2) why one would construct the claimed invention, in order to attain the goal.

For example, you could also attain the goal by paying each customer one hundred dollars.

Restated: the Answer is reasoning backward. The Answer is pointing to a supposed **characteristic** of the combined references, and asserting that this **characteristic** leads one to construct the invention. But, at best, this reasoning merely shows that the invention is desirable, because it attains the goal, or characteristics.

Desirable does not equal obvious.

Re: Answer, Page 16, Last Paragraph

This paragraph is either meaningless, incorrect, or both.

Numerous "wireless devices" will not work with Suer. Mousetraps, garage door openers, and remote car starters provide examples.

Re: Answer, Page 17, First Two Paragraphs

Point 1

The Answer admits that Suer does not teach use of a wireless telephone. (Second paragraph, first sentence.)

Then where is the teaching to install a wireless telephone ? MPEP § 706.02(j) requires that the teaching be found in the prior

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art, or knowledge of the art, but **not in Appellant's patent application.**

The teaching is absent.

Point 2

These two paragraphs are replete with the naked assertions that replacement of Suer's PDA/device by a wireless telephone to Suer is "obvious."

However, as explained herein, Suer's device performs functions which a wireless phone does not. Display 55 and its check-writing facility provide one example. The substitution of a wireless telephone removes the display 55, thereby making Suer inoperative.

It cannot be "obvious" to render Suer inoperative.

Point 3

The Answer asserts that cell phones are well known. It is believed that this assertion is made now for the first time.

Appellant traverses this assertion, and requests that a reference be cited in support of the assertion. (See MPEP § 2144.03.)

The reason is that a cell phone is being used as a substitute for the PDA/device in Suer. The latter device has characteristics (eg, display 55 and its capture of hand-written

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data) which are not found in cell phones.

Further, even if the appropriate cell phone is "well known," that fact simply removes the need to show it in a reference. Nevertheless, a teaching is still required for substituting it into the Suer reference.

Point 4

As to the last sentence of the second paragraph, Appellant points out that the substitution of a cell phone in Suer seems to make Suer **less flexible**, because certain functions of Suer (eg, hand-writing capture) have been eliminated.

Further, no definition of "flexible" has been given.

Further still, the very last phrase states that Suer, after the modification, can "receive a plurality of types of wireless devices."

That is false. After the modification, he uses cell phones alone.


Further, as explained above, no explanation has been given as to why a single user of Suer would want to hold financial data in multiple portable devices, and then transfer that data, from those devices, into the person's PC, as Suer teaches.

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CONCLUSION

Appellant requests that the Board reverse all rejections,
and pass all claims to issue.

Respectfully submitted,


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